

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of : Customer Number: 20277  
Dmitry CHERKASOV, et al. : Confirmation Number: 5625  
Application No.: 10/578,313 : Group Art Unit: 1637  
Filed: July 18, 2007 : Examiner: Jczia RILEY  
For: MACROMOLECULAR NUCLEOTIDE COMPOUNDS AND METHODS FOR USING  
THE SAME

**PETITION UNDER 37 C.F.R. § 1.181(a) TO CORRECT 35 U.S.C. § 371(c) Date**

Mail Stop PCT Legal  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is a petition for supervisory review under 37 C.F.R. § 1.181 of the Official Filing Receipt mailed on conferring a filing date of August 28, 2009. Applicant respectfully submit that the application was complete as of July 18, 2008 and as such should be granted a date of complete of the requirements of 35 U.S.C. § 371(c) of July 18, 2007.

## FACTS

1. On May 4, 2006 Applicant filed
  - a. the national fee,
  - b. a copy of the international application, PCT/EP04/12556, in German having an International Filing date of November 4, 2004
  - c. an oath of the inventors, the same inventors listed in the international application,
  - d. an abstract, specification and claims, and
  - e. A power of Attorney
2. On July 18, 2007 Applicant filed, and the USPTO accepted:
  - A. A certified English translation of the International Application, including the specification, claims, abstract and drawings.
  - B. A copy of the International Preliminary Examination Report
  - C. Preliminary amendments

See stamped postcard (Appendix A)
3. On October 9, 2007, a Notice of Acceptance of Application under 35 U.S.C § 371 and 37 C.F.R. § 1.495 was mailed listing July 18, 2007 as the date of receipt of 35 U.S.C. § 371(c)(1), (c)(2) and (c)(4) requirements and the date of completion of all 35 U.S.C. § 371 requirements. Appendix C.
4. On January 25, 2008 A Notice of Abandonment was mailed. The Notice indicated no reply was received to the Notice to File Missing Parts mailed on January 18, 2007.
5. On February 21, 2008 Applicant filed a petition to withdraw the holding of abandonment under 37 C.F.R. § 1.181(a) and response to notice of missing parts of application.

Included with the petition was a copy of postcard stamped July 18, 2007 (Appendix A) and a copy of the October 9, 2007, Notice of Acceptance of Application under 35 U.S.C § 371 and 37 C.F.R. § 1.495 (Appendix C).

6. On April 30, 2008 a Decision to Grant the February 21, 2008 petition was mailed. However, the decision stated:

A review of the application file reveals that an English translation of the international application was incomplete. While the description of the international application was provided, an English translation of Claims 1-68 is not found among the papers filed on 18 July 2007 in response to the Notification of Missing Requirements.

The Notification of Abandonment erroneously indicated that applicant had failed to respond to the 905 within the time period set forth therein and is hereby VACATED. Rather, an incomplete response to the Notification of Missing Requirements was submitted.

A Notification of Defective Response (Form *PCT/DO/EO/917*) will be issued indicating that a complete English translation of the international application, including all claims, is required.

7. On July 24, 2008 Applicant filed a response to a Notification of Defective Response, which was mailed on July 17, 2008. The response included a certified English translation of the specification and claims.

8. On August 28, 2009 a Notice of Acceptance of Application under 35 U.S.C 371 AND 37 C.F.R. § 1.495 was mailed listing July 24, 2008 as the date of receipt of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) requirements and the date of completion of all 35 U.S.C. 371 requirements.

## APPlicants' POSITION

Applicants seek to correct the date of completion of the requirements of 35 U.S.C. § 371(c) from July 24, 2008 to July 18, 2007 – the date that all 35 U.S.C. § 371 requirement were complete as evidenced by postcard stamped July 18, 2007 (Appendix A) listing:

97 pages of Specification (English Translation)

14 pages of Claims (English Translation)

1 pages of Abstract (as appendix in Preliminary Amendment)

51 pages of Formal Drawings (Replacement Sheets)

As evidenced by the postcard (Appendix A), and the July 18, 2007 Date Stamped Cover Page of Response to Notification of Missing Requirements, an English translation of the claims were submitted on July 18, 2007 (Appendix B).

According to MPEP 1893.03(b) "The Filing Date of a U.S. National Stage Application [R-5] - 1800 Patent Cooperation Treaty,":

The "Application Filing Date" field formerly displayed in PAIR was changed to "Filing or 371(c) Date" to clearly indicate that for international applications that enter the national stage under 35 U.S.C. 371, the information displayed in this field is the date of receipt of the 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) requirements. Applicants are quite often confused as to the true filing date and will ask for corrected filing receipts thinking that the information thereon is wrong. This explanation should offer some clarity. For most legal purposes, the filing date is the PCT international filing date. Exceptions to this general rule include the following:

A) Availability as a prior art reference under former 35 U.S.C. 102(c) (prior to the amendment by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). If a U.S. patent issued from an international application filed prior to November 29, 2000, the international application was not considered to have been filed in the United States for prior art purposes under 35 U.S.C. 102(e) and PCT Article 64(4)(a) until the date the application fulfilled the requirements of 35 U.S.C. 371(c) (1), (2), and (4).

(B) Availability as a prior art reference under 35 U.S.C. 102(e) as amended by the AIPA, and further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)). If an international application was filed on or after November 29, 2000, but did not designate the U.S. or was not published in English under PCT Article 21(2), the international filing date is not treated as a U.S. filing date for prior art purposes under 35 U.S.C. 102(e). See MPEP § 706.02(a) and § 2136.03.

C) Patent term adjustment under 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b) when the USPTO has failed to issue a patent within three years of the "actual filing date" of an application. In this situation, the "actual filing date" is the date the national stage commenced under 35 U.S.C. 371(b) or (f). See MPEP § 2730.

The "Date of Completion of all 35 U.S.C. 371 Requirements" included on the NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.495 (Form PCT/DO/EO/903) is relevant for purposes of patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)(II) and 37 CFR 1.702(a)(1) when the USPTO has failed to mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the requirements under 35 U.S.C. 371 were fulfilled. This date is the latest of:

- (A) the date of submission of the basic national fee;
- (B) the date of submission or communication of the copy of the international application;
- (C) the date of submission of the translation of the international application if the international application is not in the English language;
- (D) the date of submission of an oath or declaration of the inventor in compliance with 35 U.S.C. 371 (c)(4) (see 37 CFR 1.497(c) for an explanation of when an oath or declaration will be accepted as complying with 35 U.S.C. 371(c)(4));
- (E) the earlier of 30 months from the priority date or the date of request for early processing under 35 U.S.C. 371(f) if requested prior to 30 months from the priority date (Form PCT/DO/EO/903 will indicate the date early processing was requested);
- (F) if a request for early processing has not been requested prior to 30 months from the priority date, the date of submission of any translation of the annexes to the international preliminary examination report if the translation of the annexes are filed within the time period set in a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring either an English translation of the international application or an oath or declaration; and

(G) the date of submission of any surcharge for submitting the oath or declaration later than 30 months from the priority date.

From the above facts, it is clear that the filing date of the present application is the PCT international filing date November 4, 2004 and that the date that all the requirements under 35 U.S.C. § 371 were fulfilled is July 18, 2007.

#### REQUEST FOR RELIEF

Accordingly, it is respectfully requested that July 18, 2007 be listed as the date of receipt of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) requirements and the date of completion of all 35 U.S.C. 371 requirements.

Since this petition is pursuant to 37 C.F.R. §1.181, no petition fee is required.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP



Aamer S. Ahmed

Registration No. 58,958

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
Phone: 202.756.8000 ASA  
Facsimile: 202.756.8087  
**Date: September 15, 2011**

**Please recognize our Customer No. 20277  
as our correspondence address.**

Appendix A: Copy of Postcard stamped July 18, 2007 listing:

97 pages of Specification (English Translation)

14 pages of Claims (English Translation)

1 pages of Abstract (as appendix in Preliminary Amendment)

51 pages of Formal Drawings (Replacement Sheets)

Appendix B: July 18, 2007 Date Stamped Cover Page of Response to NOTIFICATION

OF MISSING REQUIREMENTS

Appendix C: Copy of NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35

U.S.C 371 AND 37 C.F.R. § 1.495 mailed October 9, 2007

Appendix D: Copy of certified English translation of specification, claims, abstract, and

formal drawings originally submitted on July 18, 2007.

# Appendix A

|  |  |  |                               |                                     |   |   |                                     |                               |              |            |
|--|--|--|-------------------------------|-------------------------------------|---|---|-------------------------------------|-------------------------------|--------------|------------|
| Applicant  | Dmitry CHERKASOV, et al.   |  |                               | Docket No.                          | 076030-0011                               |   | Serial No.                          | 10/578,313                    |              |            |
| Title:   | MACROMOLECULAR NUCLEOTIDE COMPOUNDS AND METHODS FOR USING THE SAME |  |                               |                                     |   |   |                                     |                               |              |            |
| Date Sent:   | 7/18/2007  | <input checked="" type="checkbox"/> Hand Carried | <input type="checkbox"/> Fax  | <input type="checkbox"/> Electronic | <input type="checkbox"/> Cert. of Mailing | <input type="checkbox"/> 1st Class Mail | <input type="checkbox"/> Patent No. |                               |              |            |
| Transmittal Letter   |  |  |                               |                                     |   |   |                                     |                               |              |            |
| New Patent App   | <input type="checkbox"/> Utility                                   | <input type="checkbox"/> Design                  | <input type="checkbox"/> Cont | <input type="checkbox"/> CIP        | <input type="checkbox"/> Div.             | <input type="checkbox"/> PCT            | <input type="checkbox"/> RCE        | <input type="checkbox"/> Prov |              |            |
| Other:   |  |  |                               |                                     |   |   |                                     |                               |              |            |
| 97   | pages of Specification (English Translation)                       |  |                               |                                     |   |   |                                     |                               |              |            |
| 14   | pages of Claims (English Translation)                              |  |                               |                                     |   |   |                                     |                               |              |            |
| 1  | pages of Abstract (as appendix in Preliminary Amendment)           |  |                               |                                     |   |   |                                     |                               |              |            |
| 51   | pages of Formal Drawings (Replacement Sheets)                      |  |                               |                                     |   |   |                                     |                               |              |            |
| <input checked="" type="checkbox"/> Small Entity   | <input type="checkbox"/> Large Entity                              |  |                               |                                     |   |   |                                     |                               |              |            |
| <input type="checkbox"/> Declaration/Power of Attorney   |  |  |                               |                                     |   |   |                                     |                               |              |            |
| <input type="checkbox"/> Recordation of Assignment/Security Agreement  |  |  |                               |                                     |   |   |                                     |                               |              |            |
| <input type="checkbox"/> Information Disclosure Statement  |  |  |                               |                                     |   |   |                                     |                               |              |            |
| <input type="checkbox"/> Form PTO 1449   |  |  |                               |                                     |   |   |                                     |                               |              |            |
| <input type="checkbox"/> References attached   |  |  |                               |                                     |   |   |                                     |                               |              |            |
| <input checked="" type="checkbox"/> Preliminary Amendment  |  |  |                               |                                     |   |   |                                     |                               |              |            |
| <input checked="" type="checkbox"/> Response to Missing Requirements Notice  |  |  |                               |                                     |   |   |                                     |                               |              |            |
| <input type="checkbox"/> Resp. to Notice to Correct App. Papers  |  |  |                               |                                     |   |   |                                     |                               |              |            |
| <input type="checkbox"/> Certified Copy of Priority Doc.   |  |  |                               |                                     |   |   |                                     |                               |              |            |
| <input type="checkbox"/> Claim for Convention Priority   |  |  |                               |                                     |   |   |                                     |                               |              |            |
| <input type="checkbox"/> Response/Amendment to Office Action of  |  |  |                               |                                     |   |   |                                     |                               |              |            |
| <input checked="" type="checkbox"/> Request for 4 months Extension of Time   |  |  |                               |                                     |   |   |                                     |                               |              |            |
| Check for  | \$   | <input checked="" type="checkbox"/>              | Charge Deposit Acct.          | \$ 975.00                           | Atty Int.                                 | JLT                                     | Tkpr. #                             | 6740                          | Secy. or Pl. | WPatterson |
| CNS Descip:  |  |  |                               |                                     |   |   |                                     |                               |              |            |
| 3-\$180 6-\$795  |  |  |                               |                                     |   |   |                                     |                               |              |            |
| THE PATENT AND TRADEMARK OFFICE DATE STAMPED HEREON IS ACKNOWLEDGEMENT THAT THE ITEMS CHECKED ABOVE, WERE RECEIVED BY THE PTO ON THE DATE STAMPED. |  |  |                               |                                     |   |   |                                     |                               |              |            |

# Appendix B

IAP12 Rec'd PCT/PTO 18 JUL 2007

Docket No.: 076030-0011

## PATENT

### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Customer Number: 20277  
Dmitry CHERKASOV, et al. : Confirmation Number: Not Yet Assigned  
Application No.: 10/578,313 : Group Art Unit: Not Yet Assigned  
Filed: May 04, 2006 : Examiner: Not Yet Assigned

For: MACROMOLECULAR NUCLEOTIDE COMPOUNDS AND METHODS FOR USING  
THE SAME

### RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS

Mail Stop Missing Parts  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Notification of Missing Requirements dated January 18, 2007,

submitted herewith are the following for filing in the above-referenced application:

1. 111 pages of Specification and Claims with Verified Statement of Translation
2. 51 pages of Replacement Sheets of Formal Drawings
3. Petition for Extension of Time (in separate transmittal)
4. Preliminary Amendment including an appendix containing 1 sheet of abstract.
5. Amendment Submitting Sequence Listing (on a separate postcard)
6. Paper Copy of Sequence Listing (on a separate postcard)
7. Computer-readable Copy of Sequence Listing (on a separate postcard)
8. Multiple Dependency Claims Fee of \$180.00

**Application No.: 10/578,313**

Please charge Deposit Account No. 500417 in the amount of **\$180.00**. To the extent necessary, Applicants petition for an extension of time under 37 C.F.R. 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

It is requested that the official filing receipt now be issued.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

  
Judith L. Toffenetti  
Registration No. 39,048

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
Phone: 202.756.8000 JLT:jwp  
Facsimile: 202.756.8087  
**Date: July 18, 2007**

**Please recognize our Customer No. 20277  
as our correspondence address.**

07/20/2007 GFREY1 00000053 500417 10578313  
01 FC:2616 180.00 DA



## UNITED STATES PATENT AND TRADEMARK OFFICE

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|                               |                       |                  |
|-------------------------------|-----------------------|------------------|
| U.S. APPLICATION NUMBER NO.   | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
| 10/578,313                    | Dmitry Cherkasov      | 076030-0011      |
| INTERNATIONAL APPLICATION NO. |                       |                  |
| PCT/EP04/12556                |                       |                  |
| I.A. FILING DATE              |                       | PRIORITY DATE    |
| 11/05/2004                    |                       | 11/05/2003       |
| CONFIRMATION NO. 5625         |                       |                  |
| 371 ACCEPTANCE LETTER         |                       |                  |
| <br>*OC000000026192138*       |                       |                  |

Date Mailed: 10/09/2007

## NOTICE OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C 371 AND 37 CFR 1.495

The applicant is hereby advised that the United States Patent and Trademark Office in its capacity as a Designated / Elected Office (37 CFR 1.495), has determined that the above identified international application has met the requirements of 35 U.S.C. 371, and is ACCEPTED for national patentability examination in the United States Patent and Trademark Office.

The United States Application Number assigned to the application is shown above and the relevant dates are:

|   |   |
|---|---|
| <u>07/18/2007</u>   | <u>07/18/2007</u>                                       |
| DATE OF RECEIPT OF 35 U.S.C. 371(c)(1), (c)(2) and<br>(c)(4) REQUIREMENTS | DATE OF COMPLETION OF ALL 35 U.S.C. 371<br>REQUIREMENTS |

A Filing Receipt (PTO-103X) will be issued for the present application in due course. **THE DATE APPEARING ON THE FILING RECEIPT AS THE " FILING DATE" IS THE DATE ON WHICH THE LAST OF THE 35 U.S.C. 371 (c)(1), (c)(2) and (c)(4) REQUIREMENTS HAS BEEN RECEIVED IN THE OFFICE. THIS DATE IS SHOWN ABOVE.** *The filing date of the above identified application is the international filing date of the international application (Article 11(3) and 35 U.S.C. 363).* Once the Filing Receipt has been received, send all correspondence to the Group Art Unit designated thereon.

The following items have been received:

- Copy of the International Application filed on 05/04/2006
- English Translation of the IA filed on 07/18/2007
- Copy of IPE Report filed on 05/04/2006
- Preliminary Amendments filed on 07/18/2007
- Oath or Declaration filed on 05/04/2006
- Request for Immediate Examination filed on 05/04/2006
- U.S. Basic National Fees filed on 05/04/2006
- Priority Documents filed on 05/04/2006
- Power of Attorney filed on 05/04/2006
- Specification filed on 07/18/2007
- Claims filed on 07/18/2007

- Abstracts filed on 07/18/2007
- Drawings filed on 07/18/2007

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Applicant is reminded that any communications to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above (37 CFR 1.5)

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LAMONT M HUNTER  
Telephone: (703) 308-9140 EXT 201

PART 1 - ATTORNEY/APPLICANT COPY

FORM PCT/DO/EO/903 (371 Acceptance Notice)